

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

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UNITED STATES PATENT AND TRADEMARK OFFICE

APR 23 2003

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BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JÖRG HOFMANN, PIETER OOMS, PRAMOD GUPTA,
MICHAEL SCHNEIDER and WALTER SCHÄFER

Appeal No. 2003-0409
Application No. 09/582,141

ON BRIEF

Before KIMLIN, WARREN and MOORE, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-7 and 9, all the claims remaining in the present application.

Claim 1 is illustrative:

1. A double-metal cyanide (DMC) catalyst comprising:
 - a) a double metal cyanide compound;
 - b) an organic complexing ligand; and

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- c) 2 to 80 wt. % of a polycarbonate, based on the amount of finished catalyst.

The examiner relies upon the following reference as evidence of obviousness:

Le-Khac	5,714,428	Feb. 3, 1998
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Appellants' claimed invention is directed to a double-metal cyanide (DMC) catalyst comprising a double metal cyanide compound, an organic complexing ligand, and 2-80 wt. % of a polycarbonate. According to appellants, "[t]he DMC catalysts of Appellants' claimed invention have reduced induction times and increased activity compared to known catalysts" (page 2 of principal brief, fifth paragraph).

Appealed claims 1-7 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Le-Khac.

Appellants submit at page 2 of the principal brief that "[t]he claims do not therefore stand or fall together" (last paragraph). However, the examiner has properly determined that the ARGUMENT section of appellants' brief fails to set forth any argument that is reasonably specific to a particular claim on appeal. Accordingly, all the appealed claims stand or fall together with claim 1, and we will limit our consideration of this appeal to the examiner's rejection of claim 1.

We have thoroughly reviewed each of the arguments advanced by appellants. We find ourselves in complete agreement with the examiner's reasoned analysis and application of the prior art, as well as her cogent disposition of the arguments raised by appellants. Accordingly, we will adopt the examiner's reasoning as our own in sustaining the rejection of record, and we add the following for emphasis only.

Appellants do not dispute the examiner's factual finding that Le-Khac, like appellants, discloses a DMC catalyst comprising a double metal cyanide compound, an organic complexing ligand and a functionalized polymer that, preferably, may be a polycarbonate (see paragraph bridging columns 4 and 5, particularly, column 5, line 1). Also, Le-Khac expressly teaches that the DMC catalyst may "contain from about 2 to about 80 wt. % (based on the total amount of catalyst) of the functionalized polymer" (column 5, lines 9-11), as recited in claim 1 on appeal. Accordingly, based on the Le-Khac disclosure, we are convinced that one of ordinary skill in the art would have found it obvious to prepare the claimed DMC catalyst.

A principal argument advanced by appellants is that Le-Khac discloses many functionalized polymers, and it would require much picking and choosing to select the claimed polycarbonate.

However, it is well settled that there is nothing unobvious in choosing some from among many indiscriminately disclosed by the prior art, as long as the prior art teaches that all the selections disclosed are suitable for the intended purpose.

Merck and Co. v. Biocraft Labs Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989);

In re Lemin, 332 F.2d 839, 841, 141 USPQ 814, 815-16 (CCPA 1964).

As for appellants' argument that there would have been no motivation for one of ordinary skill in the art to select polycarbonate as the functionalized polymer, we agree with the examiner that the requisite motivation arises from Le-Khac's characterization of polycarbonate as a preferred functionalized polymer.

Appellants also contend that one of ordinary skill in the art would be unable to practice the Le-Khac invention when utilizing polycarbonate as the functionalized polymer, since "[g]iven the unpredictable nature of catalysis, the skilled artisan would not have been able, without the benefit of Appellants' disclosure and without undue experimentation, to predict the change in catalytic activity disclosed by Appellants' claimed invention" (page 6 of principal brief, third paragraph). However, it is not necessary for a finding of obviousness that

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one of ordinary skill in the art would have been able to predict with absolute certainty the degree of catalytic activity associated with the use of polycarbonate as the functionalized polymer. All that is required is a reasonable expectation of success in using polycarbonate in a DMC catalyst for epoxide polymerizations, as disclosed in Le-Khac.

As a final point, although the examiner has offered an unrebutted analysis of specification data, we note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected results, by way of specification data or otherwise. Accordingly, the prima facie case of obviousness established by the examiner stands unrebutted.


In conclusion, based on the foregoing and the reasons well-stated by the examiner, the examiner's decision rejecting the appealed claims is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Edward C. Kimlin
EDWARD C. KIMLIN
Administrative Patent Judge


CHARLES F. WARREN
Administrative Patent Judge

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JAMES T. MOORE
Administrative Patent Judge

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